

E.) REMARKS/ARGUMENTS

It is applicants' intent to place the present application in condition for allowance. To this end, applicants have complied with the Examiner's rejections and objections to the maximum extent possible.

The specification has been revised to include reference to the specific alloy compositions for INCONEL® 718, WASPALOY™, RENE®-41, INCOLOY® 903, INCOLOY® 907, and INCOLOY® 909, which are well-known superalloys with specific known compositions to those skilled in the art. The specification has also been revised to include ® after the terms INCONEL®, INCOLOY®, and RENE® in all the places in which it has been used. The specification has also been revised to include ™ after the term WASPALOY™. Also, the specification has been revised to include an acknowledgement that INCONEL® is a registered trademark of Huntington Alloys Corporation of Huntington, West Virginia. The specification has also been revised to include an acknowledgement that INCOLOY® is a registered trademark of Inco Alloys International, Inc. of Huntington, West Virginia. The specification has also been revised to include an acknowledgement that RENE® is a registered trademark of Teledyne Industries, Inc. of Los Angeles, California. The specification has also been revised to include an acknowledgement that WASPALOY™ is an unregistered trademark of Haynes International, Inc. of Kokomo, Indiana. Thus, the use of INCONEL®, INCOLOY®, RENE®, and WASPALOY™ are believed to be in full compliance with the rules.

In addition, applicants have changed the reference to Inconel 907 in Paragraph 0022 to INCOLOY® 907 as the improper trademark was used to identify the superalloy in the original specification. Application submits that no new matter is added by this change as support for this change can be found in the original Claim 13. Applicants have also changed the reference to Inconel 909 in Paragraph 0023 to INCOLOY® 909 as the improper trademark was used to identify the superalloy in the original specification. Applicants submit that no new matter is added by this change as support for this change can

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be found in the original Claim 16. Applicants have also changed the reference to Inconel 903 in Paragraph 0024 to INCOLOY® 903 as the improper trademark was used to identify the superalloy in the original specification. Applicants submit that no new matter is added by this change as support for this change can be found in the original Claim 10.

In addition, the claims have been revised to remove all reference to trademarks within the claims. The words INCONEL 718, WASPALOY, RENE-41, INCOLOY 903, INCOLOY 907, and INCOLOY 909 have been replaced with their respective superalloy compositions. As such superalloy compositions are well-known to those who are skilled in the art, applicants submit that no new matter has been added due to the replacement of the trademarks with the respective superalloy compositions.

Election/Restriction

The Examiner had required restriction to one of the following inventions under 35 U.S.C. § 121:

I. Claims 1-18 and 21, drawn to a heat treatment process for restiring the properties of an aircraft engine having an INCONEL 718 cast portion, classified in class 148, subclass 675

II. Claims 19-20, drawn to an aircraft engine frame comprising a cast INCONEL 178 portion, classified in class 148, subclass 652.

Applicants affirm the provisional election of Attorney Santa Maria on May 29, 2003 and hereby elect Group I, claims 1-18 without prejudice. Applicants also note that there is not a claim 21 in the Application. Applicants respectfully traverse the requirements for restriction and request reconsideration of the restriction requirement between Group I (claims 1-18), directed to and Group II (Claims 19-20). Applicants submit that the examination of Groups I and II can be made without a serious burden on the Examiner. Independent claims 19 and 20, the basis for Group II contain the same limitations directed to the heat treatment as is recited in independent claim 1, the basis for Group I, which is the

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group elected by applications. In the course of searching the invention of Group I, the Examiner will also be searching the invention of Group II because the limitations of the claims in Group II are similar to the limitations recited in the claims of Group I. Therefore, applicants submit that since the limitations of the claims in Groups I and II are similar, it would not be a serious burden on the Examiner to examine both Groups I and II, and thus, the restriction requirement between Groups I and II should be reconsidered and withdrawn by the Examiner.

However, to expedite the examination of this Application, applicants have cancelled claims 19-20 of the Application in this Amendment rendering the restriction requirement moot.

Rejection under 35 U.S.C. § 112

This application has been reviewed in light of the Office Action of June 12, 2003. In the Office Action, claims 1-20 were pending, and claims 1-2 and 4-18 stand rejected. Again, applicants note that there is no Claim 21 in the Application. In response, claim 3 is cancelled, claims 19-20 are cancelled, claims 1, 4, 7, 10, 13, and 16 are amended, and the following remarks are submitted.

Claims 1, 4, 7, 10, 13, and 16 have been amended to include reference to the specific alloy compositions for INCONEL® 718, WASPALOY™, RENE®-41, INCOLOY® 903, INCOLOY® 907, and INCOLOY® 909, which are well-known superalloys with specific known compositions to those skilled in the art.

Claims 1-2 and 4-18 are rejected on the basis that in paragraph 0016, applicants disclosed a process step that the INCONEL 718 alloy “must undergo,” which included the heating procedure set forth in the original Claim 3. As claims 1-2 and 4-18 were silent in this regard, the Examiner rejected claims 1-2 and 4-18. The Examiner recommended that

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applicants amend claim 1 to incorporate the limitations in claim 3. As set forth in the Amendments to the Claims section of this Amendment, applicants have incorporated the limitations of claim 3 into claim 1 and have cancelled claim 3. Examiner indicated that claim 3 contained allowable subject matter and would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As all of the pending claims now include the limitations of claim 3, applicants submit that claims 1-2 and 4-18 are now in condition for allowance.

In the Office Action, the Examiner objected to the use of trademarks without capitalization and the lack of appropriate generic terminology. In response, applicants have submitted a marked-up copy and a clean copy of a substitute specification that incorporates the appropriate trademark usage and the inclusion of appropriate generic terminology that is believed to satisfy the requirements of the examiner. As the trademark designations used in the Application are well-known to one skilled in the art, applicants submit that no new matter has been included in the substitute specification.

CONCLUSION

Applicants submit that no new matter has been added by the amendments to the specification and the claims. Applicants submit that the application is now in condition for allowance, and requests such allowance. If the Examiner believes the prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact applicants' representative at the below listed telephone number.

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The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,
MCNEES WALLACE & NURICK LLC



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Attachment:

Marked-Up Copy of Substitute Specification
Clean Copy of Substitute Specification